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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/963,274 | 09/26/2001 | Arthur D. Kranzley | AP33567-070457.1062 | 8403 |
| 21003 | 7590 | 01/24/2005 | EXAMINER | |
| BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | BAYAT, BRADLEY B | |
| | | | ART UNIT | PAPER NUMBER |

3621

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,274

Applicant(s)

KRANZLEY ET AL.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Applicant has amended claim 1 in the response filed on 3 November 2004. Therefore, claims 1-5 remain pending and are again presented for examination.

Response to Arguments

Applicant's arguments filed 3 November 2004 have been fully considered but they are not persuasive.

Applicant contends that the cited reference Hogan (2002/0116341 A1) does not disclose a universal cardholder authentication field (UCAF), wherein both cardholder authentication data and purchase information are transmitted to a merchant (applicant's response page 4). Applicant further states that such purchase information may include "billing address, shipping address, card account number or expiration date (Id.). The examiner respectfully disagrees.

Hogan discloses a "universal" field accepted by all payment systems for electronic commerce (§73). In fact, Hogan discloses the advantages of using this universal field suitable for a Mode-3 payment mechanism wherein transparent authentication and authorization is accomplished while at the same time maintaining a higher degree of authentication (§74-76). Applicant's specification, specifically the description of the preferred embodiment is anticipated by the Hogan reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are further rejected under 35 U.S.C. 102(e) as being anticipated by Hogan et al., U.S. Application 2002/0116341 A1.

As per the following claims, Hogan et al. discloses:

1. A method for conducting a financial transaction with a merchant by a consumer over a communication network and involving a payment network having an issuer for authorizing said transaction based on standard authorization criteria including transaction data and based on a positive authentication of said consumer, said method comprising: utilizing one of a plurality of authentication mechanisms for providing said consumer with cardholder authentication data; utilizing a universal cardholder authentication field for transmitting to said merchant said cardholder authentication data regardless of the authentication mechanism utilized, and purchase information; generating an authorization request including said cardholder authentication data; forwarding said request over the payment network; and verifying by said issuer said authentication data and authorizing said transaction by said issuer based on said positive verification and on said standard criteria (§36-41; 73-76; 122-135178-189).

2. The method of claim 1 wherein said payment network includes a merchant's acquirer and further including the steps of passing said authentication field data along with said transaction

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data to said acquirer and generating by said acquirer said authorization request (§42-44).

3. The method of claim 2 wherein said authentication data comprises at least one of digital certificate serial numbers, digital signatures, application cryptograms and passwords established through at least one of a digital wallet server and smart card (§57-64).

4. The method of claim 3 wherein said consumer utilizes an account number for said transaction and said account number has an associated expiration date and an associated available credit line and wherein said standard authorization criteria comprises an evaluation of said expiration date and said available credit (§178-184).

5. The method of claim 4 wherein said universal cardholder authentication field is automatically populated with said cardholder authentication data (§224, 279, 281).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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